

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Matsuhiro UENO et al

Application No.: 10/657,076

Filed: September 9, 2003

For: GENE TRANSFER METHODS



Art Unit: 1636

Examiner: David Guzo

Washington, D.C.

Atty.'s Docket: UENO=8A

Confirmation No.: 9181

Date: July 14, 2006

Customer Service Window, **Mail Stop Amendment**

Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Randolph Building, 401 Dulany Street  
Alexandria, Virginia 22314

Sir:

Transmitted herewith is a REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

☒ No additional fee is required.

☐ The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 25	\$		x 50	\$
INDEP.	*	MINUS	*** 3	0	x 100	\$		x 200	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 180	\$		+ 360	\$
					ADDITIONAL FEE TOTAL			TOTAL	

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

☐ First - \$ 60.00  
☐ Second - \$ 225.00  
☐ Third - \$ 510.00  
☐ Fourth - \$ 795.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

☐ First - \$ 120.00  
☐ Second - \$ 450.00  
☐ Third - \$ 1020.00  
☐ Fourth - \$ 1590.00

Month After Time Period Set

☐ Less fees (\$ ) already paid for month(s) extension of time on .

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$ .

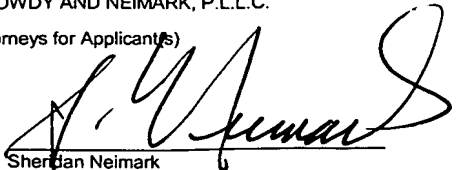
☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ .

☐ A check in the amount of \$ is attached (check no. ).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

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 Sheridan Neimark  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: UENO=8A

In re Application of:	)	Confirmation No.: 9181
	)	
Mitsuhiro UENO et al	)	Art Unit: 1636
	)	
Appln. No.: 10/657,076	)	Examiner: David Guzo
	)	
Filing Date: September 9, 2003	)	July 14, 2006
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For: GENE TRANSFER METHODS	)	

REPLY TO RESTRICTION REQUIREMENT

Customer Service Window, Mail Stop Amendment  
Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Randolph Building  
401 Dulany Street  
Alexandria, Virginia 22314

Sir:

Applicants are in receipt the Office Action mailed  
June 16, 2006, entirely in the nature of a restriction  
requirement.

As applicants have claimed priority from their two  
applications filed In Japan in 1998 and 1999, and as certified  
copies were filed in the parent application 09/743,354, U.S.  
National Phase of PCT/JP99/03403, **applicants respectfully request**  
**the PTO to acknowledge receipt of applicants' papers filed under**  
**Section 119.**

Restriction has been required among what the PTO deems  
to be six (6) patentably distinct inventions. As applicants must

make an election even though the requirement is traversed, applicants hereby respectfully elect Group IV, presently claims 13-20, 29-33 and 40-45, directed to a method of gene therapy, with traverse and without prejudice.

Applicants do not deny that the inventions may indeed be patentably distinct from one another. Applicants also see from the Office Action that each of the inventions is considered to have a separate classification, and thus a separate field of search. Nevertheless, applicants believe that a **complete** field of search of the elected Group IV claims would overlap at least **some** of the other groups, whereby there would not be a "serious burden" to examine claims from at least some of the non-elected groups.

To search and examine other groups would be fully consistent with the requirements of the second paragraph of MPEP 803, which section **requires** a search and examination of plural inventions, even when the restriction requirement is correct, if to do so would not constitute a "serious burden". Applicants accordingly request the examiner to be guided by the second paragraph of MPEP 803, and to withdraw the requirement to the extent consistent with the second paragraph of MPEP 803.

Applicants also respectfully note that the patent statute, which gives authority to the Commissioner for restriction practice, states that the Commissioner "may require the application to be restricted..." (emphasis added). Thus, even

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Amd. dated July 14, 2006  
Reply to Office Action of June 16, 2006

when restriction is proper, its imposition is discretionary, and examiners are given substantial discretion with respect to examining plural inventions in the same application. Therefore, even if the examiner disagrees with applicants' points raised above, contrary to applicants' contention that the restriction requirement should be recast into fewer groups so that one or more of the presently non-elected groups can be examined with the elected group, applicants would nevertheless respectfully request the examiner to exercise such discretion and to examine additional claims along with the claims of the elected Group IV.

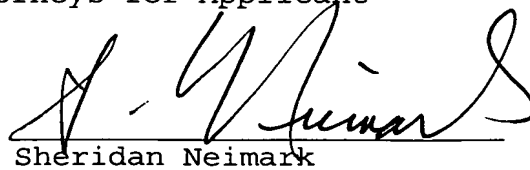
Favorable reconsideration is therefore respectfully requested for the reasons given above.

Applicants now respectfully await the results of a first examination on the merits.

Respectfully submitted,

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Attorneys for Applicant

By



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